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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,171	11/09/1999	JOHN M. KRAJNIK	5661	7614

7590                    08/13/2002

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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 08/13/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/437,171	KRAJNICK ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Judy M. Reddick	1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 03 June 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 18-26 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 18-26 are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

**Election/Restrictions**

1. **Newly submitted claims 18-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally presented claims(1-17) are drawn to "An aqueous coating composition comprising a) a binder polymer and b) a second polymer" VS the newly presented claims(18-26) are drawn to "A method for producing a coating composition". The inventions are separate and distinct, each from the other, as per having been related as product and process of use. In the instant case, the product, as claimed, can be used in an entirely different process such as a coating process wherein the components of a), the binder polymer, are formed in the presence of component b), the dispersant polymer, i.e., in-situ polymerization, and wherein the final product is absent a pigment grind.**

**Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-26 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.**

**Information Disclosure Statement**

2. **The information disclosure statement filed on 06/03/02 has been considered and placed in the application file.**

**Claim Rejections - 35 USC § 103**

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

4. **Claims 1-17 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Cruden et al(U.S. 4,176,103) in combination with Huth et al(U.S. 5,102,936) as per reasons clearly set forth in the Grounds of Rejection of record per paper no. 8, 12/03/01.**

**Response to Arguments**

5. **Applicant's arguments filed 06/03/02 have been fully considered but they are not persuasive.**

**Relative to Cruden/Huth----The crux of Counsel's arguments appears to hinge on**

**a) The copolymer dispersion disclosed in Huth et al is synthesized from monomers including "0 to 5 wt.%" of ethylenically unsaturated carbonyl compounds and b) Cruden et al does not disclose the component b) per the instant claims 1 and 8 and there is no motivation to combine the copolymer dispersion of Huth et al with the polymer latex of Cruden et al:**

**Relative to item a)--- It is well settled that an applied reference may be relied upon for all that it would have reasonably suggested to one with ordinary skill in the art including not only preferred embodiments but less preferred or even non-preferred embodiments(Merck & Co. v. Biocraft Labs, Inc.-10 USPQ 1843). The bottom line is whether the presence of the carbonyl compound(s) is optional or not, it's presence is still disclosed.**

**Relative to item b)--- It is urged and maintained that it would have been obvious, on its face, to the skilled artisan to use the carbonyl-containing copolymer-governed thickener of Huth et al, as the thickener in the composition of Cruden et al and with a reasonable expectation of obtaining its cumulative additive effect. It is tenable that the aforementioned carbonyl-containing copolymer of Huth et al**

*would only serve to enhance the properties of the paint composition of Cruden et al. There is absolutely nothing viable on this record diffusing this issue.*

**Conclusion**

6. **THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

*A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.*

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.*

Application/Control Number: 09/437,171

Page 5

Art Unit: 1713

*J. M. Reddick*

***Judy M. Reddick  
Primary Examiner  
Art Unit 1713***

*JMR JMR*  
**August 12, 2002**